

**REMARKS**

**Status of the Claims**

Claims 1-20 are pending in this application. Reconsideration and allowance of all claims are respectfully requested in view of the amendments following remarks.

**Election/Restrictions**

The Office Action has required restriction under 35 U.S.C. § 121 to one of two groups of claims as set forth on page 2 of the Office Action for the reasons set forth on page 2. The Examiner mentioned that during a telephone conversation with William Lewis on 12-6-2002, a provisional election was made with traverse to prosecute invention I, claims 1-12, and 15-20. The Examiner required that affirmation of the election must be made by the Applicants in replying to the Office Action. Affirmation of the election and reasons for traversal are made below.

As previously stated by Mr. William Lewis, the Applicants elect Group I, claims 1-12 and 15-20. The restriction requirement is respectfully traversed.

According to the M.P.E.P. § 803, if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it may include claims to independent or distinct inventions.

The Examiner must show that there would be a serious burden if the restriction is not required. Applicant respectfully submits that the Examiner nowhere contends, let alone demonstrates that a search of all the pending claims would be a serious burden. Further, at the Examiner's disposal are powerful electronic search engines providing the Examiner with the

ability to quickly and easily search all of the claims. Applicant therefore respectfully requests withdrawal of the restriction requirement and examination of all pending claims.

### **Objections to Drawings**

In the Office Action, the Examiner stated that the Examiner did not have FIG. 3, and objected to FIG. 4 for the reasons set forth on page 3 of the Office Action.

In response to the Examiner's statement that the Examiner does not have FIG. 3, Applicants file a copy of FIG. 3 herewith. As mentioned in the SUBMISSION OF COPY OF FIG. 3 filed herewith, FIG. 3 was filed with the Patent and Trademark Office on August 21, 2001 as evidenced by the attached copy of the postcard date stamped August 21, 2001 by the Patent and Trademark Office. Therefore, submitting a copy of FIG. 3 herewith does not constitute the addition of new matter.

With respect to the Examiner's objection to FIG. 4, applicants submit a REQUEST FOR APPROVAL OF DRAWING CHANGE and a copy of FIG. 4 with the change marked in red. The change is to lengthen a lead line to extend to the feature corresponding to the reference numeral. Thus, the change does not constitute the addition of new matter.

### **Priority**

On page 3 of the Office Action, the Examiner stated that the Applicant had not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) for not specifically referencing the prior application in the first sentence of the specification or an application data sheet. The Applicant respectfully submits that the Application did specifically reference the prior application on an application data sheet filed with

the application on August 21, 2001 (see first page of UTILITY PATENT APPLICATION TRANSMITTAL SHEET). However, to facilitate prosecution, the Applicant amends the specification to specifically reference the prior application.

### **Rejections Under 35 U.S.C. § 112**

Claims 1-2, 6-9, and 12 stand rejected under 35 U.S.C. § 112, second paragraph, for the reasons set forth on page 4 of the Office Action. Applicant traverses this rejection.

Applicant respectfully submits that claims 1,2,6,7, and 12 are clear as originally written. However, to speed prosecution, and in accordance with the Examiner's suggestion, Applicant has amended these claims. Applicant submits that the amendments do not effect the scope of the claims. Claim 8 contained an obvious typographic error and is amended herein to correct the typographical error. The scope of claim 8 (and its dependant claim 9) remain unchanged. Applicant respectfully requests the rejections under 35 U.S.C. § 112 be removed.

### **Rejections Under 35 U.S.C. § 102**

Claims 3 and 4 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,996,137 to Copper for reasons set forth in the office action on pages 5 and 6 of the Office Action. Claims 1-9, 11-12, and 15-17 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,000,506 to Hultgren for reasons set forth on pages 6-8 of the Office Action. Applicant respectfully traverses these rejections.

A § 102 rejection is proper only if each and every element as set forth in the claim is found – i.e., the prior art must teach every aspect of the claim. *See Verdegall Bros. v. Union Oil Co. of California* 918 F.2d 628, 631 (Fed. Cir. 1987); *see also* MPEP §2131.

(1) With respect to the rejections of claims 3 and 4 in light of Cooper, Claim 3, and thus dependent claim 4, recite “a filter media disposed in said chamber between said inlet and said outlet. . .” Applicant respectfully submits that Cooper does not teach at least this aspect of the claim.

By contrast, Cooper is directed to a generally cylindrically shaped housing containing a filter, the ports for letting the fluid in and out of the filter are located near one end of cylinder. The filter is located adjacent to the port and not between them as recited by claims 3 and 4. At least for the reason that Cooper does not teach or suggest “a filter media disposed in said chamber between said inlet and said outlet. . .” the present invention is patentably distinct from Cooper. For at least this reason, Applicant requests that the § 102 rejection in light of Cooper be withdrawn.

(2) Claims 1-9, 11-12, and 15-17 were rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 3,000,506 to Hultgren for the reasons set forth on pages 6 – 8 of the Office Action. However, the Examiner’s comments, and the FIGS. provided by the Examiner in the Office Action seem to relate to U.S. Patent No. 3,456,800 to Humbert and not the patent to Hultgren. Therefore, the Applicant’s comments herein will be made under the assumption that the Examiner meant to reject claims 1-9, 11-12, and 15-17 under 35 U.S.C. § 102 as being anticipated by the Humbert patent. The Applicant respectfully traverses these rejections.

Claim 2 and claim 15 and dependant claims 16-17 recite the language “a filter media disposed between said inlet and said outlet.” Applicant submits that Humbert does not teach or suggest at least this aspect of claims 2 and 15-17. In contrast, in Humbert, the ports for inletting and outletting fluid are located next to each other (see FIGS. 1 and 3). The filter is located

adjacent to both ports and is clearly not located between the ports. At least for the reason that Humbert does not teach or suggest “a filter media disposed between said inlet and said outlet” Applicant respectfully requests that the rejection of claims 2 and 15-17 be withdrawn.

Claim 3 and dependent claims 4-9, and 11 recite “a filter media disposed in said chamber between said inlet and said outlet.” Applicant submits that Humbert does not teach or suggest at least this aspect of the claim. Humbert is directed to a filter that is located in a housing located adjacent to inlet and outlet ports, not between them. At least for the reason that Humbert does not teach or suggest “a filter media disposed in said chamber between said inlet and said outlet” Applicant respectfully requests that the rejection of claims 3, 4-9 and 11 be withdrawn.

Claim 12 recites a “chamber having an inlet at one end and an outlet at another end.” Applicant submits that Humbert does not teach or suggest at least this aspect of the claim. As previously mentioned, Humbert is directed to a filter that has the inlet and outlet ports located next to each other. (See FIGS. 1 and 3). They can not be considered located on opposite ends of a chamber. At least for the reason that Humbert does not teach or suggest “chamber having an inlet at one end and an outlet at another end” Applicant respectfully requests that the rejection of claim 12 be withdrawn.

For at least for the reasons explained above, Applicant requests that the § 102 rejections of claims 1-9, 11-12, and 15-17 be withdrawn.

### **Rejections Under 35 U.S.C. § 103**

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cooper in view of U.S. Patent No. 6,139,737 to Gizowski for reasons set forth in the Office Action on page 9. Applicant respectfully traverses this rejection.

Claim 10 is dependant on claim 3, and at least for the reasons stated above, claim 3 is patentable over Cooper. Therefore, claim 10 is patentable over Cooper by reason of its dependency.

For at least this reason, Applicant respectfully requests the rejection of claim 10 under 35 U.S.C. § 103(a) be withdrawn.

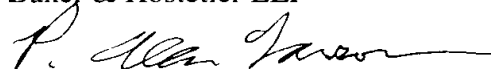
### CONCLUSION

It is therefore respectfully submitted that the application is in condition for allowance and such action is hereby solicited.

Any extension of time necessary to prevent abandonment is hereby requested, and any fee necessary for consideration of this response is hereby authorized to be charged to Deposit Account No. 50-2036.

Respectfully submitted,

Baker & Hostetler LLP



P. Alan Larson

Registration No. 53,184

Date: March 10, 2003  
Baker & Hostetler LLP  
Washington Square, Suite 1100  
1050 Connecticut Avenue, N.W.  
Washington, D.C. 20036  
Telephone: (202) 861-1500  
Facsimile: (202) 861-1783

APPENDIX

Amended claims 1, 2, 6-8 and 12:

1. (Amended) A dual direction bypass valve for a fluid filter, comprising:

a first retainer which houses a first spring, the first retainer engaging the first spring at one end of the first spring, and a first disk disposed at another end of said first spring; and

a second retainer, disposed opposite to said first retainer, said second retainer [which] houses a second spring, the second retainer engaging the second spring at one end of the second spring, and a second disk disposed at another end of said second spring;

wherein said second disk is operative to compress said second spring in a first direction toward said second retainer; and

wherein said first disk is operative to compress said first spring in a second direction toward said first retainer, said first direction which is opposite to said second direction.

2. (Amended) A fluid filter comprising:

an inlet for passage of fluid into said filter;

an outlet for passage of fluid leaving said filter;

a filter media disposed between said inlet and said outlet, for filtering said fluid;

a valve body comprising:

a first retainer which houses a first spring, the first retainer engaging the first spring at one end of the first spring and a first disk disposed at another end of said first spring;  
and

a second retainer, disposed opposite to said first retainer, said second retainer [which] houses a second spring, the second retainer engaging the second spring at one end of the second spring, and a second disk disposed at another end of said second spring; and

an end cap separating said first disk from said second disk;

wherein said second disk is operative to compress said second spring in a first direction toward said second retainer; and

wherein said first disk is operative to compress said first spring in a second direction toward said first retainer, said first direction being opposite to said second direction.

6. (Amended) The fluid filter according to Claim 3, wherein said reverse flow bypass means includes:

a front valve body having a first retainer housing a first spring, the first retainer engaging the first spring at one end of the first spring, and a first disk disposed at another end of said first spring; and

an end cap against which said first disk is seated, said end cap having holes in a periphery of said end cap which are sealed by said first disk;



wherein said first disk is operative to compress said first spring, moving said first disk from said end cap and opening up said holes for said fluid to pass through said front valve body to said outlet, bypassing said filter media.

7. (Amended) The fluid filter according to Claim 6, wherein said forward flow bypass means includes:

a rear valve body having a second retainer housing a second spring, the second retainer engaging the second spring at one end of the second spring, and a second disk disposed at another end of said second spring;

wherein said end cap includes a central aperture, and said second disk is disposed against said end cap sealing said central aperture; and

wherein said second disk is operative to compress said second spring, to allow said fluid to pass through said central aperture, through said rear valve body to said outlet, bypassing said filter media.

8. (Amended) The fluid filter according to Claim 3, wherein said second fluid flow path leads from said inlet through [said] a front valve body and through [said] a rear valve body toward said outlet, bypassing said filter media.

12. (Amended) A fluid filter comprising:

a housing defining a chamber, said chamber having an inlet at one end and an outlet at another end, through which fluid passes from said inlet to said outlet;

a filter media disposed between said inlet and said outlet, which filters said fluid;

a front valve body having a first retainer housing a first spring, the first retainer engaging the first spring at one end of the first spring, and a first disk disposed at another end of said first spring;

an end cap against which said first disk is seated, said end cap having holes in a periphery of said end cap which are sealed by said first disk, and said end cap having a central aperture;

a rear valve body having a second retainer housing a second spring, the second retainer engaging the second spring at one end of the second spring, and a second disk disposed at another end of said second spring, said second disk sealing said central aperture of said end cap; and

a stabilizing spring disposed between said first retainer and said housing within said chamber, to hold said front valve body stably within said chamber;

wherein said first disk is operative to compress said first spring in a first direction, moving said first disk away from said end cap and opening up said holes in said periphery of said end cap, allowing fluid to pass through said holes and said front valve body to exit said filter, bypassing said filter media; and

wherein said second disk is operative to compress said second spring, to allow said fluid to pass through said central aperture of said end cap from said front valve body, through said rear valve body to exit said filter, bypassing said filter media.